## REMARKS/ARGUMENTS

Applicants have received the Office Action dated July 6, 2007, in which the Examiner: 1) rejected claim 16 under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite; 2) rejected claims 1, 2, 4-8, 10, 11, 13, 15-19 and 21-27 under 35 U.S.C. § 103(a) as allegedly obvious under Shuster (U.S. Pub. No. 2005/0097059, hereinafter "Shuster") in view of Miller et al. (U.S. Pub. No. 2004/0261070, hereinafter "Miller"); and 3) rejected claims 3, 9, 12, 14 and 20 under 35 U.S.C. § 103(a) as allegedly obvious under Shuster in view of Miller and further in view of Official Notice. With this Response, Applicants amend claim 16. Based on the amendment and arguments herein, Applicants respectfully submit that all claims are in condition for allowance.

### I. REJECTIONS UNDER 35 U.S.C. § 112, 2ND PARAGRAPH

The Examiner rejected claim 16 under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite because of an antecedent basis issue. Applicants have amended claim 16 to correct the antecedent basis issue. Accordingly, Applicants respectfully request that the Examiner remove this rejection.

### II. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 4-8, 10, 11, 13, 15-19 and 21-27 under 35 U.S.C. § 103(a) as allegedly obvious under Shuster in view of Miller. Applicants respectfully traverse this rejection.

Claim 1 requires "determining a quality value for a target software based on performance of the target software." Claim 1 further requires "computing a merit-based licensing fee for the target software based on the quality value." The Examiner contends that Shuster discloses "computing a merit-based licensing fee for the target software based on the quality value." The Examiner admits that Shuster fails to disclose "determining a quality value for the target software based on the performance level" and so the Examiner turns to Miller. However, the hypothetical combination of Shuster and Miller cannot be used to reject claim 1 because Shuster and Miller cannot be combined. According to MPEP

§ 2143.01 (VI), a 35 U.S.C. § 103(a) rejection is improper if it modifies a reference by changing the reference's principle of operation: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." As Applicants explain below, adding Miller to Shuster impermissibly alters Shuster's principle of operation. Thus, Shuster and Miller cannot be used to reject claim 1.

Shuster is directed to a system by which consumers of digital music files (*e.g.*, MP3 files) may purchase one or more licenses for digital music files that have been downloaded without a proper license. *See* Shuster, paragraph [0013]. Shuster teaches that the price for a license is determined by analysis of the digital music file. In particular, the digital music file may be analyzed based on a sampling rate of the music file, length of the file, version of the file and the type of work downloaded. Paragraph [0037]. Clearly, the type of analysis taught by Shuster involves analyzing the digital music file itself. Metrics (*e.g.*, sampling rate, length of file, version of file) of the digital music file that are electronic properties of the file are used to determine the price for a license. This type of digital file analysis is part of the principle of operation of Shuster, because Shuster uses these analyses in generating checksums of the digital music file, which are later used to calculate a licensing price. Paragraphs [0032]-[0035]. Shuster does not teach or even suggest actually **performing** (*e.g.*, playing) the digital music file to measure metrics or to determine the price for a license. Performance of the file is not needed and thus is not taught by Shuster.

Further, performance of a digital music file in Shuster would be nonsensical. For example, performance of the digital music file might entail a computer playing the file over speakers and then capturing the audible music via a microphone for analysis. Clearly, such a technique would be inefficient, unnecessary and nonsensical. In another example, performance of the digital music file in Shuster might entail playing the music file to a group of human

listeners who then rate the music file quality and provide their ratings to the computer that plays the music. However, such a technique would not only constitute a drastic alteration of Shuster's principle of operation, but would also render Shuster inadequate for its intended purpose (substantially automatic analysis of digital music files) in violation of MPEP § 2143.01(V), which states: "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

By contrast, Miller requires the actual performance of software to detect software bugs. Miller is directed to a system that automatically detects and corrects software bugs. Miller clearly teaches that the detection of software bugs is done by a monitoring system that "watches" while multiple persons use the software. In particular, "as the software . . . is being used, its performance is automatically monitored based on predetermined monitoring criteria." Miller, paragraph [0007]. Unlike Shuster, whose principle of operation includes non-performance analysis of digital music files, Miller teaches that the actual **performance** of software is used to determine the quality of the software. Thus, combining Miller, which teaches performance-based analysis, with Shuster, which teaches non-performance-based analysis, would impermissibly alter Shuster's principle of operation in violation of MPEP § 2143.01 (VI). For at least this reason, Applicants respectfully submit that claim 1 is patentable over the hypothetical combination of Shuster and Miller. Dependent claims 2-15 are patentable for at least the same reasons as is claim 1.

Independent claim 16 requires "wherein, upon executing the code, the CPU computes a merit-based licensing fee for a target software based on a quality value associated with the target software." As explained above, Shuster and Miller cannot be combined in a 35 U.S.C. § 103(a) rejection. Thus, claim 16 is patentable over the hypothetical combination of Shuster and Miller. Dependent claims 17-21 are patentable for at least the same reasons as is claim 16.

Independent claim 22 requires a processor that "measure[s] a performance level of the target software based on the operation logs," "determine[s] a quality value for the target software based on the performance level" and "compute[s] a licensing fee for the target software based on the quality value." As explained above, Shuster and Miller cannot be combined in a 35 U.S.C. § 103(a) rejection. Thus, claim 22 is patentable over the hypothetical combination of Shuster and Miller. Dependent claims 23-24 are patentable for at least the same reasons as is claim 22.

Independent claim 25 requires "means for measuring a performance level of a target software," "means for determining a quality value for the target software based on the performance level" and "means for computing a licensing fee for the target software based on the quality value." As explained above, Shuster and Miller cannot be combined in a 35 U.S.C. § 103(a) rejection. Thus, claim 25 is patentable over the hypothetical combination of Shuster and Miller. Dependent claims 26-27 are patentable for at least the same reasons as is claim 25.

The Examiner also rejected claims 3, 9, 12, 14 and 20 as allegedly obvious under Shuster in view of Miller and further in view of Official Notice. However, Applicants respectfully submit that this rejection is moot in light of the facts that Shuster and Miller cannot be combined (as explained above) and that Official Notice fails to satisfy the deficiencies of Shuster and Miller.

## III. CONCLUSION

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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